

REMARKS

The present application was filed on June 15, 2000 with claims 1-80. Claims 45-48, 55, 60, 61 and 78-80 were canceled in the response to the first Office Action. Claims 1-44, 49-54, 56-59 and 62-77 remain pending. Claims 1, 24, 37, 41, 49, 56, 58, 62, 65 and 70 are the independent claims.

Applicants initially note that claim 50 is both rejected (Second Office Action, p. 2) and described as allowable if rewritten in independent form (Second Office Action, pp. 1 and 8). In this response, Applicants assume that the latter description is correct with respect to this claim.

In the Office Action, claims 37-40, 49, 51 and 54 are rejected under 35 U.S.C. §103(a) as being unpatentable over U.S. Patent No. 6,658,002 to Ross et al. (hereinafter "Ross"). In addition, claims 70-72, 74 and 76 are rejected under 35 U.S.C. §103(a) as being unpatentable over U.S. Patent No. 6,118,760 to Zaumen et al. (hereinafter "Zaumen"). Claim 75 is rejected under 35 U.S.C. §103(a) as being unpatentable over Zaumen in view of Ross. Finally, claim 70 is further rejected under 35 U.S.C. §103(a) as being unpatentable over U.S. Patent No. 6,798,788 to Viswanath et al.

Claims 1-36, 41-44, 56-59 and 62-69 are allowed. Claims 50, 52, 53, 73 and 77 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form.

In this response, Applicants traverse the §103(a) rejections of claims 37-40, 49, 51, 54 and 75, as indicated below. Claims 70-72, 74 and 76 are currently canceled. Claims 73, 75 and 77 are rewritten in independent form including all of the limitations of their base claim and any intervening claims.

Applicants initially note that, with respect to the §103(a) rejection of claims 37-40, 49, 51, 54 and 75, the Manual of Patent Examining Procedure, Eighth Edition, August 2001 (MPEP) §2142 states that, for an obviousness rejection, "there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings." Moreover, the Federal Circuit has stated that "particular finding must be made as to the reason the skilled artisan with no knowledge of the claimed invention would have selected these components for combination in the manner claimed."

In re Sang-Su Lee, 277 F.3d 1338, 1343 (Fed. Cir. 2002). This factual inquiry whether to combine or modify references must be “based on objective evidence of record.” Id. Mere “conclusory statements” by an examiner are inadequate to address factual questions of motivation. Id.

In formulating the §103(a) rejection of claim 37, the Examiner states on pp. 3-4 of the Second Office Action:

Referring to claim 37, Ross . . . does not explicitly teach of determining whether to compare the values of one or more fields of at least some of the plurality of frames to entries of a list of policies of groups of frames. However, determining based on the rule elements loaded into the CAM, the comparing will either match a CAM entry or not is disclosed in (col. 5 lines 10-14) (*sic*). Therefore it would have been obvious to one having ordinary skill in the art at the time the invention was made to have included determining whether to compare the values of one or more fields of at least some of the plurality of frames to entries of a list of policies of groups of frames because it is part of a rule-based routing or switching decision process (col. 6 lines 1-4) such as ACL processing as suggested by Ross et al.

To the extent that Applicants understand these comments, Applicants respectfully disagree. The Examiner correctly states that Ross, unlike the present invention, does not teach or suggest a step comprising determining whether to compare the value of one or more fields of at least some of the plurality of frames to entries of a list of policies. Beyond this, however, the Examiner merely states that a “rule-based routing” or a “switching decision process” relies on a comparison step. Such an argument, therefore, fails to address why one skilled in the art would be motivated to modify Ross to include an additional process step comprising determining whether to make a comparison as required under the MPEP and under case law from the Federal Circuit.

Moreover, Ross actually teaches away from the “determining” step in claim 37. “A reference may be said to teach away when a person of ordinary skill, upon reading the reference, would be discouraged from following the path set out in the reference, or would be led in a direction divergent from the path that was taken by the applicant.” In re Gurley, 27 F.3d 551, 553 (Fed. Cir. 1994). Ross teaches that frames in a packet are compared to a lookup table in order to form a “rule-based routing or switching decision process, such as an access control list (ACL)” (Ross, col. 6, lines 1-4). Ross, therefore describes processes in which a comparison step is always performed. Accordingly, it is

likely that Ross would discourage a person of ordinary skill in the art from performing the step of determining whether to make a comparison because such a person would think that a determining step is unnecessary since a comparison step is always performed.

Based on the foregoing, Applicants respectfully assert that claim 37 would not have been obvious at the time the invention was made. Dependent claims 38-40 are believed allowable for at least the reasons identified above with respect to claim 37, and these claims are also believed to specify additional separately patentable subject matter relative to Ross and other prior art of record.

With respect to the §103(a) rejection of claim 49 over Ross, the Examiner correctly states that Ross “does not explicitly teach of creating entries in the list for less than all of the compared frames for which no match was found in the comparison to the list” (Second Office Action, p. 3). Consequently, in order to explain a motivation to modify Ross to make claim 49 obvious, the Examiner states:

Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to have included creating entries in the list for less than all of the compared frames for which no match was found in the comparison to the list in order to provide for additional level of flexibility for rule element checking as suggested by Ross et al.

Applicants respectfully submit that this explanation does not include objective evidence of record that would motivate one skilled in the art to modify the proposed reference as required by the Federal Circuit. Instead the above quoted language concerning an “additional level of flexibility for rule element checking” is precisely the type of subjective, conclusory statement that the Federal Circuit has indicated provides insufficient support for an obviousness rejection. Applicants respectfully request that the §103(a) rejection of claim 49 be withdrawn. Moreover, dependent claims 51 and 54 are believed allowable at least for the reasons identified with respect to claim 49.

Similarly, in formulating the §103(a) rejection of claim 75 over Ross in view of Zaumen, the Examiner correctly states that “Zaumen . . . does not explicitly teach wherein determining whether the received frame requires non-default policy enforcement comprises checking whether the frame

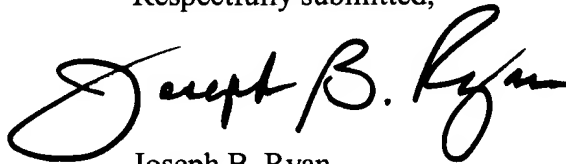
violates security rules” (Second Office action, p. 6). However, in order to explain a motivation to combine Zaumen and Ross, the Examiner states: states on pp. 6-7 of the Second Office Action:

Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to have included determining whether the received frame requires non-default policy enforcement comprises checking whether the frame violates security rules in order for the CAM to enhance the efficiency of rule processing by providing an additional level of flexibility for rule element checking as suggested by Ross et al.

Applicants again respectfully submit that this explanation also does not include objective evidence of record that would motivate one skilled in the art to make the proposed reference combination but rather contains subjective, conclusory statements that the Federal Circuit has indicated provide insufficient support for an obviousness rejection. As a result, Applicants respectfully request that the §103(a) rejection of claim 75 also be withdrawn. Notwithstanding the traversal, claim 75 has been rewritten in independent form, as indicated above.

In view of the above, Applicants believe that claims 1-44, 49-54, 56-59 and 62-69, 73, 75 and 77, as amended, are in condition for allowance, and respectfully request the withdrawal of the §103(a) rejections.

Respectfully submitted,



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Joseph B. Ryan
Attorney for Applicant(s)
Reg. No. 37,922
Ryan, Mason & Lewis, LLP
90 Forest Avenue
Locust Valley, NY 11560
(516) 759-7517